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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,489	10/29/2003	David Warren Teale	WEAT/0532	5726
36735	7590	10/26/2005		
PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD, SUITE 1500 HOUSTON, TX 77056				
			EXAMINER THOMPSON, KENNETH L	
			ART UNIT 3672	PAPER NUMBER

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/696,489

Applicant(s)

TEALE ET AL.

Examiner

Kenn Thompson

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3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 19,20,28-33 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,21-27,34,37 and 39 is/are rejected.
- 7) ☒ Claim(s) 35,36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/05/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 19, 20, 28-33 and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II-VIII, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 29 August 2005.

Claim Objections

Claims 34-37 and 39 are objected to because of the following informalities:

The recitation "the substantially flat differential surface area" in claim 34, line 15 should be changed to "a substantially flat differential surface area".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6-18, 34 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson, U.S. 5,030,071.

Regarding claims 1, 6, 8, 9 and 16, Simpson discloses a tool (1) for use in a wellbore, a housing (2) having a shaped inner bore (3), a first end (at 10), a second end (at 12); a rotor (6) having a plurality of extendable members (8), a chamber (9a,9b) and an axial fluid pathway (4

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or 5 or 11) including inlet (4) and a separate second fluid path (11) capable of allowing a ball to pass therethrough.

As to claims 7, 15 and 37, Simpson discloses a split flow arrangement (col. 3, lines 47-53).

As to claims 10, 11 and 17, Simpson discloses a restriction (12) causing a backpressure inherently capable of serving as an indication of a condition (col. 3, lines 37-53).

As to claim 12, Simpson discloses a biasing member (col. 3, lines 37-39).

Regarding claims 13, 14, 18, 34, Simpson discloses a tool (1) for use in a wellbore, a housing (2), a rotor (6) having a plurality of extendable members (8), a first fluid pathway formed by the shaped inner bore (3) and chamber (9a,9b) between the rotor and inner bore including a inlet (4) and outlet (5); and a separate second fluid pathway (11) in the rotor. Simpson discloses extending the members (8) into the chamber to form a differential surface area between an outer surface of the rotor and the shaped inner bore (col. 3, lines 27-36), pumping fluid through the inlet to pressurize a chamber; creating a force thereby causing the rotor to rotate; and exhausting fluid through the outlet.

Claims 1-5, 13, 21-27, 34 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Webb, U.S. 3,388,755.

Regarding claim 1-4, 23, 25, and 39 Webb discloses a housing (22) having a shaped inner bore (see fig 5-7, cross-section of 22), a first end (at 24) and a second end (at 23); a rotor (21) having a plurality of rectangular shaped extendable (and retractable) members (40) wiping the inner bore (col. 5, lines 47-56), a chamber (35), and a substantially axial fluid pathway (43-46) through the chamber (35), wherein the fluid pathway includes an inlet (43,44) proximate the first end and an outlet (45,46) proximate the second end.

As to claim 5, Webb discloses the rotor (21) support (29) lubricated (col. 3, lines 27-40) by fluid communicated through the fluid pathway (col. 4, line 73 – col. 5, line 19).

Regarding claim 13, 21, 22 and 34, Webb discloses a housing (22); a rotor (21) having a plurality of extendable members (40), a first fluid pathway (within 21) including a chamber (25) formed between the shaped inner bore and the rotor, a second fluid pathway (43-46; 35) separate from the first fluid pathway having an inlet (43,44) and outlet (45,46), a plurality of holes (41a) formed in the rotor (21) allowing fluid passage and a biasing member (41) for biasing the members outward. Webb discloses extending the members (40) into the chamber (35) to form a differential surface area between an outer surface of the rotor and the shaped inner bore, pumping fluid (col. 5, lines 20-30; 57-70) through the inlet to pressurize a chamber; creating a force thereby causing the rotor to rotate; and exhausting fluid through the outlet.

As to claim 24, Webb discloses members (40) are extendable into a chamber (35) to form a substantially flat differential surface area (slender axially extending space between 34 and 21).

As to claims 26 and 27, Webb discloses a second fluid pathway (within 21) allowing fluid communication through the downhole tool, inherently capable of allowing a ball to pass therethrough and being separate from the fluid pathway (43-46).

Allowable Subject Matter

Claims 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including the method step of pumping a ball through the second fluid conduit.

The prior art of record does not disclose or suggest all the claimed subject matter including cleaning an area of the wellbore below the motor by pumping fluid through the second fluid pathway.

Conclusion

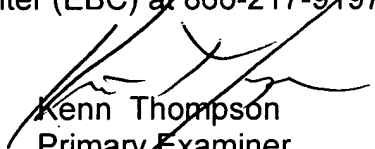
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 571 272-7037. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

29 September 2005



Kenn Thompson
Primary Examiner
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